

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/824,483	05-May-04	TARO TOKUHIRO, ET AL.	39303.20239.00

Title: METHOD FOR SELLING ITEMS USING A NETWORK

Art Unit	Paper Number
----------	--------------

Correspondence Address:
DAVID L. FEHRMAN
MORRISON & FOERSTER
555 WEST FIFTH STREET, SUITE 3500
LOS ANGELES, CA. 90013-1024

PATENT & TRADEMARK OFFICE
MAILED
JUL 26 2004
LICENSING & REVIEW

Please find attached a communication from the Examiner regarding the
Petition for Retroactive License under 37 CFR 5.25.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

David L. Fehrman
Morrison & Foerster LLP
555 West Fifth Street, Suite 3500
Los Angeles, California 90013-1024

In re: Tokuhiko et al : DECISION ON REQUEST
Serial No.: 09/824,483 : UNDER 37 CFR 5.25
Filing date: March 30, 2001
Docket No: 39303.2023900

Title: **METHODS FOR SELLING ITEMS USING A NETWORK**

This is a decision on the petition filed on May 5, 2004 for retroactive foreign filing license.


37 CFR 5.25(a) requires the following:

1. A listing of each of the foreign countries in which the unlicensed patent application material was filed,
2. The dates on which the material was filed in each country,
3. A verified statement (oath or declaration) containing:
 - i. An averment that the subject matter in question was not under a secrecy order at the time it was filed abroad, and that it is not currently under a secrecy order,
 - ii. A showing that the license has been diligently sought after discovery of the proscribed foreign filing, and
 - iii. An explanation of why the material was filed abroad through error and without deceptive intent without the required license under § 5.11 first having been obtained, and
4. The required fee (§ 1.17(h)).

The petition is denied under 37 CFR 5.25 (3)(iii). In order to secure a retroactive foreign filing license, applicant or petitioners must provide evidence that the subject matter was filed abroad through error and without deceptive intent. The instant petition fails in that it lacks sufficient evidence to conclude that the material was filed abroad through error and without deceptive intent. Specifically, the petition needs to elucidate upon circumstances that led to discovery of the proscribed filing. Mr. Mizuno avers that "during this time, (presumably between March 9, 2001 and March 20, 2001 he became aware of possible filing license requirements for inventions made in the US". However, the statement regarding awareness of the proscribed filing is not supported by facts (i.e., copies of any necessary supporting documents such as letters of transmittal or instructions for filing) to support the statement of error of filing and more

specifically, the circumstances of when and how he became aware of the requirements and thus the error of filing abroad before securing a foreign filing license.

Accordingly, the provisions of 37 CFR 5.25 not having been fully met, the petition is denied, and in the absence of any response within **60 days** of the mailing date of this letter, such denial will be made final and the final action under 35 U.S.C. 185 will be taken. Extensions of time may be had under 37 C.F.R. 1.136(a).

A handwritten signature in black ink, appearing to read 'Ian J. Lobo', with a stylized, cursive script.

Ian J. Lobo
Patent Examiner
(703) 306-4161